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09/755,305	01/02/2001	Gen Suzuki	F-6806	5011

7590
Jordan and Hamburg
122 East 42nd Street
New York, NY 10168

12/11/2003

EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,305

Applicant(s)

SUZUKI, GEN

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The rejection of claims 1-11 under 35 U.S.C. §112, second paragraph for having an improper antecedent basis has been withdrawn due to the amendment filed 01 October 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4, 5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive.

Regarding claims 1 and 11, Darrow presents a board game, that is a route composed by arranging a plurality of squares displayed on a gaming board (FIG 1) where there is a lottery device (FIG 5) for determining a value. Characters (FIG 2) are provided for moving the player along the route according to the value determined by the lottery device (Column 9 (as counted by Examiner), lines 36-39). Darrow also incorporates events related to the squares that are produced when the character lands at a specific stop position. Darrow incorporates events of

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either financial benefit or loss relating to a character landing upon on a specific square, such as Community Chest or Chance (Column 2, lines 35-38).

It is well known in the art that board games, such as the one disclosed by Darrow, can be incorporated into a program on a computer readable storage medium for play on a computer or gaming console using an image display device. In an article about Darrow's board game (created as an electronic version) adapted for Nintendo 64, the author notes how little character tokens have taken on full 3D splendor with color and animation (IGN.com, page 1).

Because of this advantage it would be obvious to one skilled in the art at the time of invention to incorporate the game disclosed by Darrow into an electronic version, to enhance user enjoyment. Furthermore, one skilled in the art would know that to craft this electronic version specific electronic devices and functionality would be required. Any game that is adapted into a gaming console must have the basic requirements of a game screen, input device, and gaming control. There must be an image display for which the user can view the game, there must be an input device for outputting a signal according to user interaction, and finally the game must have some sort of control, which would coordinate the functionality among the devices required for the game to function properly including checking the input device and displaying images.

To construct the functionality of the board game disclosed by Darrow into an electronic version, one skilled in the art would know that the display device would be used for displaying the route which is comprised of the squares as well as symbols representing attributes allocated to the squares (see FIG 1, below).

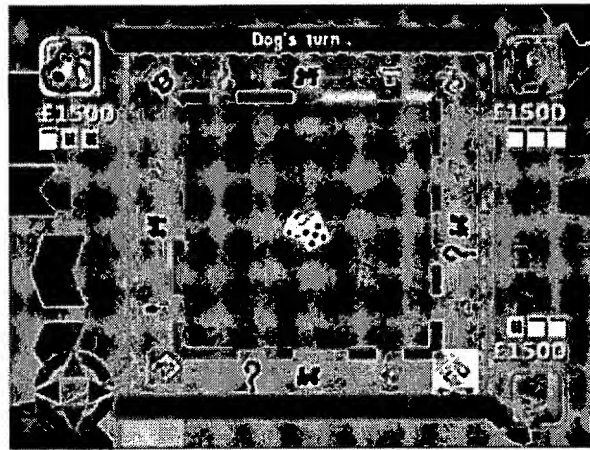


FIG 1: Screen Shot from N64 showing a display of a route composed of arranging a plurality of squares as well as symbols.

Furthermore, as die are required in the game as disclosed by Darrow, in an electronic version, one skilled in the art would understand that a lottery device (controlled by user input) for determining a value as a result of player input would be obvious. Further, a skilled artisan would understand that as the player must roll the die, this lottery value would be obtained based on the player's instruction through the input device (see FIG 2, below).

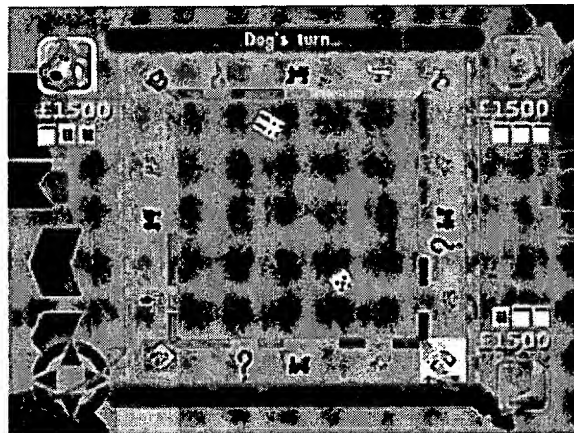


FIG 2: Screen shot from N64 showing the lottery devices used for obtaining a value based upon the player rolling the die.

Darrow discloses that his characters move around the gaming board based upon the result of the lottery device. Therefore, in an electronic version incorporating this same concept,

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the characters would be set as objects and would be operated by the value determined by the lottery device (see FIG 3, below).

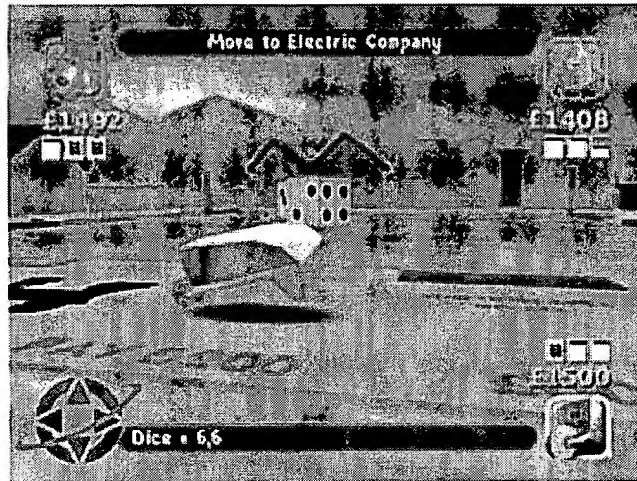


FIG 3: Screen shot from N64 showing the character moving along the route as a result of the value obtained from the lottery device (shown in background and on bottom of screen).

Darrow incorporates events on the squares; therefore, a means for controlling a value relating to an event based upon the stop position of the character would be incorporated into an electronic version by one skilled in the art in order for the game to realize the exact location of a character, as knowing the position of each character would be axiomatic to the functionality of the game. Furthermore, because this value provides the game control device with the location of the character, it would be obvious to a skilled artisan that the value would also serve to be used in order to adjust the appearance of the event production squares when the player lands on a certain square, thus the value is controlled and corresponds to the attributes of the square based on the stop position (see FIG 4, below, value associated the player landing on the square with the ability to instantiate an event based on that landing).

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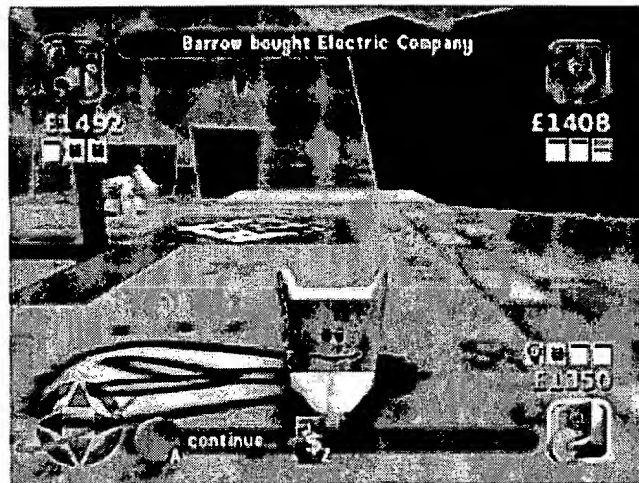


FIG 4: Screen shot from N64 with the presentation of the square adjusted based upon the position of the character.

As Darrow discloses that events can occur based upon the character landing on a certain square, such as Community Chest or Chance, the electronic version would also incorporate these events and one skilled in the art would know that based on the rules of Darrow and the design shown by Monopoly 64, that the appearance of at least one event production square (FIG 5, below) would be based upon the value calculated as described above. This event production square (FIG 5, below) would produce an event relating to the square itself (FIG 5, Community chest square produces the event square which shows Pay Hospital \$100). This event would be produced based upon the appearance of the event production square (FIG 5, below) and the stop position of the character that has the predetermined relationship as the stop positions corresponds to the initial square that produced the event production square.

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FIG 5: Screen shot from N64 showing an event relating to an event production square, in this case when the character hit the stop position upon Community Chest

In view of the discussion above, it would have been obvious to one skilled in the art at the time of invention to incorporate the devices and controls in order to adapt the concepts of the board game of Darrow into the user-friendly and convenient atmosphere of an electronic gaming console environment.

In regards to claim 4, Darrow discloses characters in his game board and in the electronic version these characters can be animated in video sequences or stories relating to events in the game and the game is always proceeding as the stories occur and change as they are incorporated into the game. Hasbro Interactive discusses such an example. If it is determined that a character hits a certain space where the particular event is to be "sentenced" to another square, an animation is run and a token is catapulted or otherwise sent to jail (page3, lines 31-32) in a short story sequence.

In regards to claim 5, one skilled in the art would know that a gaming system as disclosed above would have an ending control device to realize when the current game has ended and selecting a proper ending from a plurality of endings and presenting an image relating to the ending. The proceeding situation of game play by the characters would

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determine which of the plural endings is to be presented based upon a win by any one of the players. It would be crucial to player satisfaction to present these ending images in order for the players to see the results of the game in order to be able to assess performance and establish victory.

In regards to claim 9, Darrow incorporates events on the squares, therefore a means for controlling a value relating to an event based upon the position of the character would be incorporated into an electronic version by one skilled in the art, as discussed above. This would be done in order to realize the exact location of a character as knowing the position of each character would be axiomatic to the functionality of the game. This value would be adjusted based upon the position of the character, thus when the character is moving forward around the board, one of ordinary skill in the art would understand the pointer value associated with the location would be increased to correspond to the player position. When the value reaches a certain predetermined number associated with an event, it is determined that the character has stopped on an event, and the game control device will control the appearance of the event production square associated therein and allow it to appear.

In regards to claim 10, Darrow discloses that events can occur based upon the character landing on a certain square, such as Community Chest or Chance, the electronic version would also incorporate these events and one skilled in the art would know that an event control device would be used to realize when a character has stopped on a square associated with an event and thus producing the event.

Regarding claim 11, one of ordinary skill in the art understands that the gaming program of Monopoly 64 as disclosed above would be on a computer readable storage medium with a program for executing the steps disclosed above.

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Claims 2, 3, 6/1, 6/2, 6/3, 6/4, and 6/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive in further view Oshima et al. (US Patent No. 5,601,487).

What Darrow and Hasbro Interactive disclose, teach, and/or suggest has been discussed above and is incorporated within.

Applicant admits that a reason that many of current video games are likely to become dreary is that because each event square is related to each event, even if a player wants to experience the event related to the square, it is impossible unless the square is arranged in the route. Further, Applicant admits that a system that is capable of allowing player's wish to reflect on production of events is desirable (page 2, 9-17).

Oshima et al. also teaches that when users cannot directly influence the results of the game, it can become monotonous and not interesting (Column 1, lines 20-21). To overcome the fault, Oshima et al. disclose an indicator, which controls the progress of the game, that is displayed on the display and its contents are scrolled at a speed based upon the selected character. The indicator can then be stopped in response to an external operation and the progress of the game is controlled based upon the indicator (Column 1, lines 55-63). Further, it would be axiomatic to the functionality of the scrolling indicator to have a device to determine the value that was selected by the user.

The problem with lottery devices independent of user control stated above is present in the gaming system disclosed by Darrow in view of Hasbro Interactive. With the teachings from Applicant's admission and Oshima et al., it would have been obvious to one skilled in the art at the time of invention to incorporate a user-driven lottery device, such as the one disclosed by Oshima et al., as opposed to a random lottery device into the game system of Darrow and Hasbro Interactive in order for it to become more appealing to users as they would feel they

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have been given some control over the game. With this incorporation, users would have better chances of landing on the spaces in which the desire to visit and more excitement would be provided as user would feel that the fate of their turn and the result of the game does not rest solely on fate, but on skill.

Further, regarding claim 3, the method in which the system of Darrow is modified to employ the teachings of Oshima et al. would be a design choice based upon the desires of a skilled artisan. It would be obvious to one of ordinary skill in the art to incorporate a scrolling number device that relied on a player to stop the scroll to achieve a number, as it would conform to the teachings of Oshima et al. which uses a scrolling input selection as well. Because of the different nature of the games, a skilled artisan would understand that scrolling across numbers would be obvious to the intent of Darrow as opposed to a scrolling ball, which is required, by the intent of Oshima et al. Thus, one of ordinary skill in the art would be motivated to apply the teachings of Oshima et al. to the game of Darrow in order to correct the problem identified by Oshima et al. in that when users cannot directly influence the results of the game, it can become monotonous and not interesting. Thus, implementing a lottery device that allows user to directly influence the results would be obvious to a skilled artisan and one would be motivated to use a scrolling number device in order to meet this requirement while preserving the purpose of the lottery device in Darrow.

Regarding claims 6, the teachings of Oshima et al. incorporated into Darrow, as disclosed above, would allow the player's skill for the input device to reflect on the result of the event as the player would have the ability to directly influence the results, and thus the greater the skill, the more likely the results can be positive for the player.

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Claims 7/6/1, 7/6/2, 7/6/3, 7/6/4, and 7/6/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive further in view of Oshima et al. further in view of Stamper et al. (US Patent No. 5,267,734).

What Darrow, Hasbro Interactive and Oshima et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Stamper et al. disclose that allowing a user to play a sequence before the actual time of gaming is allowed as the player can practice for the upcoming event with the aim to successfully accomplish the requirements of the game sequence when it really counts (Column 2, lines 32-37). In regards to the device discussed above that incorporates the concept of Darrow in an electronic environment with a spinner based upon skill, it would have been obvious to one skilled in the art at the time of invention, based upon the teaching of Stamper et al., to allow players to have a practice time before the actual game. This would allow the players to become more skilled at operating the lottery device and more comfortable with their ability to correctly choose the result desired from the lottery device when the time counts.

Claims 8/6/1, 8/6/2, 8/6/3, 8/6/4, and 8/6/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive further in view of Oshima et al. (US Patent No. 5,601,487).

What Darrow, Hasbro Interactive, and Oshima et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

One skilled in the art would know that a gaming system as disclosed above would have an ending control device to realize when the current game has ended and selecting a proper ending from a plurality of endings and presenting an image relating to the ending. It is well known in the art to create a multiplicity of different endings and display specific ones based

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upon the performance and circumstances of the game in order to keep player interest. The system would need to have endings associated with a win by any one of the players and it would be crucial to player satisfaction to present these ending images in order for the players to see the results of the game in order to be able to assess performance and establish victory. Therefore, the ending presented in the system is directly based upon the experience and result of the game up to that point.

Response to Arguments

Applicant's arguments filed 01 October 2003 with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's previous arguments relating to above grounds of rejection (filed 24 February 2003), the Examiner asserts that the value used in Darrow does cause an event production square to appear when a condition relating to the value is satisfied. As disclosed above, the value in Darrow would be used to keep track of the player position relating to a square. Therefore, when the player position causes the value to represent a certain square, thus a certain value, an event associated with that square and value occurs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent No. 3,834,711: Gaming system rotating a light bulb beneath the playing area through a plurality of positions allowing selective manual operation by players as they can bring

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the light bulb to a halt at a random position to provide a chance selection of one of the playing positions (Abstract).

US Patent No. 3,425,699: Teaches that electrical games of chance are known to the art wherein a motor is employed to drive a rotary switch to serially light lamps on a display board where in a player controls the device (Column 1, lines 32-35).

US Patent No. 2,587,381: Amusement apparatus which by simple manipulation of control means will present a signal of the character depending upon how long a period of time the control means is engaged by the operator (Column 1, lines 4-8). The symbols of selection are presented in a row of predetermined range (FIG 1).

US Patent No. 6,331,145: Teaches that a player who does not have any physical control over the action of the lottery device is prevented from determining the outcome of the lottery device. Consequently, the computer versions of games are less exciting since the lack an important element of the game, the feel and control over the lottery device. (Column 1, lines 18-23).

Carruthers Company: In their game show, PRESS YOUR LUCK, as described on <http://gscentral.net/pylhista.htm> by Brad Francini, a board was incorporated in which a light would dance around and when the contestant hit the red button presented in front of them, the light would stop at the square and the contestant would receive an event based upon the result of the input from hitting the red button.



Screen shot of game board from Carruthers Company with

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scrolling light device for scrolling a predetermined range of the numbers where the scrolling of the lights is stopped based upon input by the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

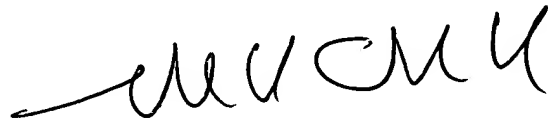
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm

cmm

December 1, 2003



MICHAEL O'NEILL
PRIMARY EXAMINER